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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,032	11/20/2006	Robert Eric Talbot	1022702-000328	7262
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EXAMINER HRUSKOCI, PETER A				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 09/22/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/576,032

Applicant(s)

TALBOT ET AL.

Examiner

/Peter A. Hruskoci/

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-38 and 43-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-38 and 43-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 35-38 and 43-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 35, 56, and 57 "THP+" is vague and indefinite because it is unclear how this term further limits the claims. It is suggested that applicants amend the claims to recite – tetrakis (hydroxyorgano) phosphonium (THP+) as described on page 1 of the instant specification, to overcome this rejection. Claims 36-38 and 43-55 depend from claim 35.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-38 and 43-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fidoe et al. 6,926,836 in view of Funkhouser et al. 6,192,987. Fidoe et al. disclose (see col. 1 line 11 through col. 7 line 50) a method for the treatment of an aqueous system substantially as claimed. The claims differ from Fidoe et al. by reciting that the formulation includes a specific alcohol having an acetylenic bond in the carbon backbone. Funkhouser et al. disclose (see col. 3 line 40 through col. 6 line 10) that it is known in the art to utilize the recited alcohol to aid in inhibiting corrosion on metal surfaces in contact with iron sulfide precipitates. It would have been obvious to one skilled in the art to modify the method of Fidoe et al. by including the recited alcohol in the formulation in view of the teachings of Funkhouser et al., to aid in inhibiting corrosion in the aqueous system. The specific ratios utilized, would have been an

obvious matter of process optimization to one skilled in the art, depending on the specific system treated and results desired, absent a sufficient showing of unexpected results.

Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fidoe et al. 6,926,836 in view of Davis et al. 5,606,105. Fidoe et al. disclose (see col. 1 line 11 through col. 7 line 50) a method for the treatment of an aqueous system substantially as claimed. The claims differ from Fidoe et al. by reciting that the formulation includes a reaction product of the salt and a specific alcohol having an acetylenic bond in the carbon backbone. Davis et al. disclose (see col. 3 line 35 through col. 6 line 47) that it is known in the art to react phosphite or phosphonium salts and the recited alcohol, to form a reaction product including phosphonate compounds or oligomers for inhibiting scale and corrosion in aqueous systems. It would have been obvious to one skilled in the art to modify the method of Fidoe et al. by including the recited reaction product in the formulation in view of the teachings of Davis et al., to aid in inhibiting scale and corrosion in the aqueous system. The specific ratios utilized, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific system treated and results desired, absent a sufficient showing of unexpected results.

Applicants' election with traverse of Group II Claims 35-38 is acknowledged. The traversal is based on assertions why the claims of Groups I and II should be properly examined together. This is not found persuasive since Group I nonelected claims 39-42, have been canceled. The requirement is still deemed proper and is therefore made FINAL.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Peter A. Hruskoci/ whose telephone number is (571) 272-1160. The examiner can normally be reached on Monday through Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/17/09

/Peter A. Hruskoci/
Primary Examiner
Art Unit 1797